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Technology Center 2100

In re Application of: Erik J. Snapper et al.)
Application No. 09/388,351)
Filed: September 1, 1999)
For: SYSTEM AND METHOD FOR)
POPULATING FORMS WITH)
PREVIOUSLY USED DATA)
VALUES)

**DECISION ON PETITION
UNDER 37 CFR § 1.181 TO
Invoke SUPERVISORY
AUTHORITY**

This is a decision on the petition under 37 CFR §1.181, filed September 16, 2003, requesting withdrawal of the finality of the Office action (Paper No. 11) mailed on July 16, 2003.

The Petition is **GRANTED**.

RELEVANT CASE HISTORY

Petitioners filed an affidavit under 37 CFR §1.131 on June 16, 2003 in an attempt to antedate a reference applied by the Examiner in a rejection under 35 U.S.C. §103 in the Office action of mail date December 19, 2002. In response, the Examiner issued a Final rejection (mail date July 16, 2003) in which, *inter alia*, new grounds were used to reject independent unamended claims 16 and 21. The Examiner indicated that the filing of a declaration necessitated the new grounds of rejection, thus allowing the Examiner to issue a Final rejection.

Petitioner filed the instant petition on September 16, 2003 contending that the final rejection issued by the Examiner in Paper No. 11 was premature because a declaration under 37 C.F.R. 1.131 is not a reply which justifies making the subsequent action final despite new grounds of rejection.

RELIEF REQUESTED

The instant petition treated under 37 CFR §§ 1.181 requests the withdrawal of the Finality of the rejection of claims 3-28 and 31-55 contained in Paper No. 11.

BASIS OF OPINION

M.P.E.P. §706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's *amendment of the claims* nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). [Emphasis added]

When applying any 35 U.S.C. 102(e)/103 references against the claims of an application filed on or after November 29, 1999, the examiner should anticipate that a statement averring common ownership at the time the invention was made may disqualify any patent or application applied in a rejection under 35 U.S.C. 103 based on 35 U.S.C. 102(e). If such a statement is filed in reply to the 35 U.S.C. 102(e)/103 rejection and the claims are not amended, the examiner may not make the next Office action final if a new rejection is made. See MPEP § 706.02(l)(3).

OPINION

The first cited paragraph implies that the application of new grounds of rejection prevent an action from being made final except in the two specific situations provided therein. The second cited paragraph addresses the recently added practice of removal of a reference based on a statement of common ownership. The examiner is advised not to rely on solely on the possibly commonly owned art as it can reasonably be anticipated that the commonly assigned reference will be removed by the filing of an appropriate statement.

In the instant case, the 102(e) date of the Atlas reference was June 19, 1998. Despite the fact that the effective date of the application under examination (September 1, 1999) is more than 1 year after the effective filing date of the reference, (in analogy to the situation with respect to a statement of common ownership) it is reasonable for the examiner to anticipate the filing of an affidavit to antedate the Atlas reference. Furthermore, as the Examiner had cited the Capps reference, which qualifies as prior art under 35 U.S.C. §102(b) and is therefore not subject to being antedated by affidavit, the prudent course would have been to apply this rejection in the first Office action. This would be consistent with the goal of compact prosecution and would have avoided putting Applicant to the expense and trouble of producing an affidavit.

The new grounds of rejection applied to unamended claims 16 and 21 were not necessitated by *amendment of the claims*, but rather on the Examiner's decision not to rely on the Atlas reference. Accordingly, the examiner's holding of Finality with respect to the rejections of record in Paper No. 11, is premature.

CONCLUSION

The petition is **GRANTED**. The finality of the Office action is withdrawn. Office records will be corrected to reflect that the Office action of mail date July 16, 2003 is Non-Final.

The undersigned notes that the Office action of July 16, 2003 does not address the sufficiency of the affidavit.¹ The next Office action should clarify whether (and on what basis) the affidavit has been deemed effective to establish a date of invention² or whether the Examiner has merely chosen to apply new art and thereby avoid evaluating the affidavit as being no longer relevant.

The application is being forwarded to the technology center support staff to enter the response filed September 16, 2003 (concurrent with the petition). After processing, the application will be forwarded to the Examiner for appropriate action.

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¹ The Examiner's attention is directed to MPEP §§ 715- 715.07 as to the proper manner in which to evaluate the sufficiency of an affidavit to establish prior invention.

² The examiner's indication that applicants' amendment changed "the effective filing date" is not correct. An affidavit under 37 C.F.R. §1.131 can be used to establish prior invention thus removing from the category of prior art references which only qualify as being "before the invention by applicant ". (See., 35 U.S.C. § 102(a) and(e)). The effective filing date of the application remains unchanged.